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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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05/04/2005

Stephen C P Joseph

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

09/16/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/533,743	<b>Applicant(s)</b> JOSEPH, STEPHEN C P	
	<b>Examiner</b> MADELINE GONZALEZ	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7,9-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

In response to applicant's amendment dated 7/6/10

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9-11 and 13-21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph et al. (WO 02/085533 A1) [hereinafter Joseph WO02], in view of Joseph et al. (WO 98/32539) [hereinafter WO98], Lutz et al. (U.S. 2002/0148763) [hereinafter Lutz] and Spearman et al. (U.S. 5,916,435) [hereinafter Spearman].

With respect to **claims 10, 11 and 21**, Joseph WO02 discloses a paint reservoir attached to a spray gun, as shown in Fig. 24, having:

- a container 309 made of a plastic material (see page 24, lines 15-21 and page 15, lines 11-13) and having a lid, a collapsible sidewall (see page 24, lines 15-21) and a base on which the side wall can stand unsupported in an upright position, as shown in Fig. 21;
- said container 309 capable of being mounted on a hand held spray gun 310 for supply of the liquid to an inlet of the spray gun 310 through an opening in the lid, and said lid also having a filler opening 330, separate from the

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opening for connection to the spray gun 310, for adding liquid to the container 309;

- a collapsible filter that fits in the filler opening 330 (see page 27, lines 16-22);
- the container including an open-topped container 309 and a lid 310 arranged to close the open end of the container 309 and forming the end wall in which the filler opening 330 is formed;
- the container 309 being collapsible as liquid is withdrawn from the container 309 (see page 24, lines 15-21) and the container 309 can be extended from a collapsed condition and filled with the filter in place (see page 25, lines 10-15).

Joseph WO02 **lacks** the filter having a tubular body, a support collar integral with the tubular body and having a lip portion and a neck portion, the support collar connected to a cage that surrounds the tubular body of the filter, and the cage being flexible.

With respect to the filter having a tubular body and a support collar: Joseph WO98 teaches a spray gun and reservoir assembly, as shown in Fig. 12, having a filter 37 having a body closed at one end and open at the other end, the open end being provided with a collar 38 that fits in a filler opening. The filter 37 filters the paint before exiting the spray gun. The body of the filter can have any shape (see page 14, lines 17-18). It would have been obvious to provide the assembly disclosed by Joseph WO02 with a filter having a collar as taught by Joseph WO98 in order to filter the paint before using the spray gun and to properly support the filter at the filler opening (see page 14,

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lines 4-16). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tubular shape to the filter disclosed by Joseph WO02 since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)), and since Joseph WO98 is suggesting that any shape can be used (see page 14, lines 17-18).

With respect to the collar having a lip portion and a neck portion and being integral with the tubular body: Spearman teaches a filter cartridge 40 having a cage portion 51, said cage portion 51 including a housing adapter 50 (collar) having a lip portion and a neck portion, as shown in Fig. 3, in order to support the cage in a filter housing (see col. 7, lines 35-40). It would have been obvious to provide the collar disclosed by Joseph WO98 with a lip portion and a neck portion as taught by Spearman in order to support the filter in the container (see col. 7, lines 35-40). Furthermore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make collar integral with the tubular body disclosed by Joseph WO98, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (*See MPEP 2144.04 [R-1] (V) [In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)).

With respect to the support collar connected to a cage that surrounds the tubular body of the filter, and the cage being flexible: Lutz teaches a screen cylinder 64, as

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shown in Fig. 2, disposed in a perforated frame 68 (cage), said frame 68 retains and support a screen media 66 during operation. The frame 68 further includes retainer rings 82 (collar) fixed at the ends of the frame 68. The frame 68 is flexible and can be used for any screening application because, among other things, it decreased likelihood of crack-related failure (see paragraph 0098). It would have been obvious to provide the filter disclosed by Joseph WO02 in view of Joseph WO98 and Spearman with a flexible cage connected to the collar and surrounding the tubular body of the filter, as taught by Lutz, in order retain and support the filter and to decreased the likelihood of crack-related failure (see paragraph 0098).

The limitation “sufficiently flexible to allow the filter and cage to collapse along the whole length of the filter as the container side wall collapses” in claim 10, lines 19-20, claim 11, lines 15-16, and claim 21, lines 14-15, is considered to be a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the filter and cage disclosed by Lutz is sufficiently flexible and capable of allowing the filter and cage to collapse along the whole length of the filter as the container side wall collapses.

With respect to **claim 7**, the combination of Joseph WO02, Joseph WO98 and Lutz discloses wherein the cage 68 includes a plurality of legs extending from the support collar 82 at the open end of the tubular body, as shown in Fig. 2 of Lutz, to a

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base member at the closed end of the tubular body, as shown in Fig. 12 of Joseph WO98.

With respect to **claim 9**, the combination of Joseph WO02, Joseph WO98 and Lutz discloses wherein the tubular body of the filter is provided with at least one annular support hoop 94 spaced from the collar 82, as shown in Fig. 8 of Lutz.

With respect to **claim 13**, Joseph WO02 discloses wherein the lid 210, 310, is provided with an extension sleeve or cage 280, 281 surrounding the container 209, 309, as shown in Fig. 19.

With respect to **claim 14**, Joseph WO98 discloses wherein the elongate tubular body of the filter 37 is tapered toward the closed end, as shown in Fig. 12.

With respect to **claim 15**, Joseph WO02 discloses wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the container, as shown in Fig. 28.

With respect to **claim 16**, Joseph WO02 discloses wherein the container 309 is characterized by a shape having a longitudinal axis and the filler opening 330 is offset from the container longitudinal axis, as shown in Fig. 24.

With respect to **claim 17**, Joseph WO02 discloses wherein the filler opening 330 is not an open end of the container 309, as shown in Fig. 24.

With respect to **claim 18**, Joseph WO02 discloses wherein the container 309 includes a container 309 and a circular lid, and the filler opening 330 has a diameter of one-half the diameter of the lid or less, as shown in Fig. 24.

With respect to **claim 19**, Lutz discloses wherein the at least one annular support hoop 94 is integral with the filter body, as shown in Fig. 8.

With respect to **claim 20**, Joseph WO02 discloses wherein the container 309 is cylindrical, the lid is circular, the filler opening 330 in the lid is larger than the opening for connection to the spray gun, and both of said openings are offset from the longitudinal axis of the container, as shown in Fig. 24.

With respect to **claim 21**, Joseph WO02 in view of Joseph WO98, Spearman and Lutz discloses all the claimed subject matter stated above, with respect to claims 10 and 11, with the exception of the cage integral with the filter mesh body. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the cage integral with the filter mesh body disclosed by Joseph WO02 in view of Joseph WO98, Spearman and Lutz, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece



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construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (See *MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

### ***Response to Arguments***

Applicant's arguments with respect to claims 7, 9-11 and 13-21 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., collapse in use) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The cage disclosed by Lutz is capable of collapsing; however, it does not collapse during use and cannot be extended from a collapsed condition, and these features are not claimed by applicant.

In response to applicant's argument that Joseph WO02 lacks the limitation of claim 15 in the embodiment shown in Fig. 24: This argument is persuasive; however, the embodiment of Fig. 28 shows a filler opening 430 oriented at an angle, and therefore, the filter body supported on said opening 430 will be oriented at an angle, as claimed by applicant.

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In response to applicant's argument the references lack the cage integral with the filter mesh body, as claimed in claim 21: It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the cage integral with the filter mesh body disclosed by Joseph WO98, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (*See MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, W, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797

Madeline Gonzalez  
Patent Examiner  
September 9, 2010